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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/597,320	06/19/2000	Gregg R. Sorensen	00512.00.0007	6520

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VEDDER PRICE KAUFMAN & KAMMHOLZ
222 N. LASALLE STREET
CHICAGO, IL 60601

EXAMINER

CHIN, RANDALL E

ART UNIT	PAPER NUMBER
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1744

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DATE MAILED: 06/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

mk-9

Office Action Summary

Application No.

09/597,320

Applicant(s)

SORENSEN, GREGG R.

Examiner

Randall Chin

Art Unit

1744

-- **Th MAILING DATE of this communication appears on the cover sheet with the corresponding address --**
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9, 10 and 26 is/are pending in the application.
- 4a) Of the above claim(s) 1-3, 9, 10 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 4-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Claims 1-3, 9, 10 and 26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 8.

2. Applicant's election with traverse of Figs. 9, 9A, claims 4-7, in Paper No. 8 is acknowledged. The traversal is on the ground(s) that the species of Figs. 1-7, 10 and the species of Figs. 9, 9A should be part of the same species since the species of Figs. 9, 9A could easily have the paint well feature of Fig. 4 and is merely an optional feature of the pad. This is not found persuasive because the 2-element pad having different porosities as shown by the species of Figs. 9, 9A is deemed patentably distinct from the single pad species of Figs. 1-7, 10.

The requirement is still deemed proper and is therefore made FINAL.

Drawings

3. The drawings are objected to because numerals 80a and 92 as shown in Figs. 9 and 9A are not in the specification. Numeral 12 as shown in Fig. 10 is not in the specification.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: axially inner portion 91, inner portion 91a, margin 93a, and body 90a (see p.17, lines 1-9).

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "94" has been used to designate both the inner face of wells (Fig. 4) and edge of pad (Figs. 9, 9A). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

5. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.
6. The disclosure is objected to because of the following informalities: On p.16, lines 30 and 35, it appears the references to "Fig. 8" should read –Figs. 9, 9A—instead. On p.17, consistent terminology should be used with respect to "working surface 76a" (lines 4-5) and "axially outer, exposed convex surface 76a" (lines 5-6). Similarly, consistent terms should be used for "portion 23" (p.17, lines 35-36) and "contact area 23" (p.18, line 5).

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. Claims 4-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4, line 12, "said applicator pad body portion" lacks proper antecedent basis. On line 14, "said backer" lacks antecedent basis. On line 14, consistent terms should be used with respect to "said body". On line 14, the "tapering" feature appears to be redundant of the converging feature as recited up on lines 12-13 and makes the claim scope vague.

Claim 5, line 4, with respect to what is the "exposed portion" referring to? In other words, such an "exposed" feature has never been positively recited.

Claim 6, line 8, consistent terms should be used for "said radial flange". On line 11, "said layer" lacks antecedent basis. On line 13, "said outermost backing edge" lacks antecedent basis. On line 16, "said surfaces" lack antecedent basis. On line 17, it appears "body portion" should read --body portions--. On lines 17-18, the recitation of "inner and outer layers" makes the claim confusing since the term "outer surfaces" has already been set forth on line 16.

Claim 7, line 2, "said backer" lacks antecedent basis.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 4 is rejected under 35 U.S.C. 102(b) as being anticipated by Zecchini '677.

10. As well as claim 4 is understood, the patent to Zecchini '677 teaches all of the recited subject matter. As for Zecchini's device to be used as a paint applicator pad adapted to be rotated in use to apply a band of paint having a sharp trim edge portion and opposed feather edge portion of reduced thickness, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In any event, Zecchini's teaches that the device is a pad for dispensing products in liquid, pasty or pulverulent form (col.1, lines 15-16) which can be paint. As for the claim reciting that the pad has a center portion adapted to be received over a spindle on lines 6-7, such recitation has not been positively recited and only requires the ability to so perform.

Allowable Subject Matter

11. Claim 5 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 6-7 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Kemp, Gesell, Turcotte, Nathanson, Engelsher, Morris, DeForest, Andros, and Boggs are pertinent to various sponge or foam arrangements.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randall Chin whose telephone number is (703) 308-1613. The examiner can normally be reached on Monday through Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Warden can be reached on (703) 308-2920. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



R. Chin
June 9, 2003

Randall Chin
Primary Examiner
Art Unit 1744